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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/593,751	06/11/2007	Murray Edward Bruce Leighton	769-400	3250
51468	7590	06/29/2009	EXAMINER	
DAY PITNEY LLP			GERRITY, STEPHEN FRANCIS	
ACCOUNT: ILLINOIS TOOL WORKS INC.				
7 TIMES SQUARE			ART UNIT	PAPER NUMBER
NEW YORK, NY 10036-7311			3721	
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			06/29/2009	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/593,751	LEIGHTON, MURRAY EDWARD BRUCE
	<b>Examiner</b>	<b>Art Unit</b>
	Stephen F. Gerrity	3721

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 23 March 2009.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-3 and 5-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-3 and 5-21 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 22 September 2006 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/23/09</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
|  | 6) <input type="checkbox"/> Other: _____ .                        |

## **DETAILED ACTION**

### **Information Disclosure Statement**

1. Receipt is acknowledged of an Information Disclosure Statement, filed 23 March 2009, which have been placed of record in the file. An initialed, signed and dated copy of each of the PTO-1449 forms is attached to this Office action.

### **Claim Rejections - 35 USC § 112**

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-3, 5-11, 16 and 20 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, line 12, "the slider" lacks proper antecedent basis -- it is suggested that the limitation "wherein grooves in the turret ... the slider on each pre-cut zipper length" be deleted from lines 12 and 13, and moved to after the end of line 15.

Claim 2, line 1, the language "to which" should perhaps be changed to --wherein- - for purposes of clarity.

Claim 5 depends from canceled claim 4. Perhaps claim 5 should be amended to depend from claim 1.

Claim 7, lines 1 and 2, the phrase "slider-mounting means" lacks antecedent basis and should be changed to --slider mounting device--.

Claim 7, line 3, the phrase "slider-mounting means" lacks antecedent basis and should be changed to --slider mounting device--.

Claim 7, line 4, "the device" should be changed to --the engaging device-- for purposes of clarity.

Claim 16, line 2, it is suggested that the expression "means of" be changed to --use of--.

Claim 20, line 3, it is suggested that the word "fitting" be changed to --filling--.

These and any other informalities should be corrected so that the claims may particularly point out and distinctly claim the subject matter which applicant regards as the invention, as required by 35 U.S.C. § 112, second paragraph.

#### **Claim Rejections - 35 USC § 102**

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 12 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Fraser (US 1,960,580).

The Fraser reference discloses a pair of convex shaped rollers 17, 17 in figure 5. The rollers are adjustably mounted as discussed beginning at page 2, line 133 of Fraser. The Fraser rollers are fully capable of performing the functional recitations found in claim 12 concerning having a zipper pass therethrough and to engage the zipper profiles and to separate from each other to allow the sliders to pass therebetween. These recitations in claim 12 are functional and statements of the intended use of the roller device, it has been held that a recitation with respect to the

manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

6. Claims 12 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by DeBolt et al. (US 5,319,430).

The DeBolt et al. reference discloses a pair of convex shaped rollers 34, 36 in figure 2. The rollers are adjustably mounted as seen by the arrow 63 in figure 1 of DeBolt et al.. The DeBolt et al. rollers are fully capable of performing the functional recitations found in claim 12 concerning having a zipper pass therethrough and to engage the zipper profiles and to separate from each other to allow the sliders to pass therebetween. These recitations in claim 12 are functional and statements of the intended use of the roller device, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

#### **Claim Rejections - 35 USC § 103**

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 5-9, 14, 15 and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leighton (GB 2,349,603) in view of Buchman (US 6,588,176).

Regarding claim 1, the Leighton reference discloses an apparatus for applying pre-cut lengths of zipper transversely to a web 24 and to then feeding the web including the zippers to a form/fill/seal machine. The Leighton reference teaches the use of a rotary driven turret 20 including grooves (formed from guides 28, 30) for receiving the pre-cut lengths of zipper, and that a heated sealing bar 36 is used to remove the pre-cut lengths of zipper from the grooves of the turret and to attach the zippers to the web in a transverse manner to the direction of movement of the web 24. The Leighton reference teaches structure which is deemed to meet all of the various means-plus-function limitations recited in claim 1 and thus meets all of applicant's claimed subject matter with the exception of the slider mounting device for mounting sliders on the zipper, and that the means for feeding pre-cut lengths of zipper comprising first and second interengageable profiles includes a slider mounted thereon. Furthermore, the Leighton reference does not teach that the grooves in the turret include a wider portion for receiving the slider on each pre-cut zipper length.

The use of zippers including sliders is notoriously old and well known in the relevant art in order to form reclosable bags in which the slider is used to separate interlocking profiles. It is also notoriously old and well known in the art for reclosable zippered bags to be formed with or without a slider mounted on the zipper.

The Buchman reference teaches a similar type of apparatus and method for transversely attaching zippers including a slider mounted thereon, in which, the slider is applied to the zipper before the zipper is pre-cut and then attached to the web as is seen in figure 4.

It would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified the Leighton apparatus by having included a device for mounting sliders on the zipper, as disclosed by Buchman, for the purpose of providing a consumer with a finished bag which includes a slider mounted on the zipper to make opening/closing of the reclosable zipper easier. Furthermore, it is routine for a skilled artisan to combine the teachings and structure of old and well known devices and methods when such a combination would achieve predictable and successful results.

Concerning the limitation that the grooves in the turret include a wider portion for receiving the slider on each pre-cut zipper length, and that each wider portion extends to slightly beyond the mid-point of its respective groove from an insertion end thereof (claim 5), it would have been an obvious matter of engineering choice to change the shape of the grooves in order to accommodate the slider mounted on the zipper in the now modified Leighton apparatus, since such a modification would have involved a mere change in the shape or form of a component. A change in shape or form is generally recognized as being within the level of ordinary skill in the art. In re Dailey, 149 USPQ 47 (CCPA 1976). Furthermore, a skilled artisan when reviewing the combination of Leighton and Buchman would have been well aware of the need to accommodate the shape of the slider mounted on the zipper length so as to permit the slider mounted on the zipper to be inserted in the groove of the turret. It being obvious that a skilled artisan would have modified the shape of the turret grooves to

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accommodate the shape of the slider mounted on the zipper length based on the provision of obvious-to-try rationale.

Regarding claims 14 and 17, the Leighton reference discloses a method for applying pre-cut lengths of zipper transversely to a web 24 and to then feeding the web including the zippers to a form/fill/seal machine. The Leighton reference teaches the use of a rotary driven turret 20 including grooves (formed from guides 28, 30) for receiving the pre-cut lengths of zipper, and that a heated sealing bar 36 is used to remove the pre-cut lengths of zipper from the grooves of the turret and to attach the zippers to the web in a transverse manner to the direction of movement of the web 24. The Leighton reference meets all of applicant's claimed subject matter with the exception of the feeding of pre-cut lengths of zipper step in which each zipper length includes first and second interengageable profiles including a slider mounted thereon. Furthermore, the Leighton reference does not teach that the grooves in the turret include a wider portion for receiving the slider on each pre-cut zipper length.

As stated earlier, the use of zippers including sliders is notoriously old and well known in the relevant art in order to form reclosable bags in which the slider is used to separate interlocking profiles. It is also notoriously old and well known in the art for reclosable zippered bags to be formed with or without a slider mounted on the zipper.

The Buchman reference teaches a similar type of apparatus and method for transversely attaching zippers including a slider mounted thereon, in which, the slider is applied to the zipper before the zipper is pre-cut and then attached to the web as is seen in figure 4.

It would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified the Leighton method by having had the step of feeding pre-cut lengths of zipper have each zipper length include first and second interengageable profiles and a slider mounted thereon, as suggested by Buchman, for the purpose of providing a consumer with a finished bag which includes a slider mounted on the zipper to make opening/closing of the reclosable zipper easier. Furthermore, it is routine for a skilled artisan to combine the teachings and structure of old and well known devices and methods when such a combination would achieve predictable and successful results.

Concerning the limitation that the grooves in the turret include a wider portion for receiving the slider on each pre-cut zipper length, it would have been an obvious matter of engineering choice to change the shape of the grooves in order to accommodate the slider mounted on the zipper in the now modified Leighton apparatus, since such a modification would have involved a mere change in the shape or form of a component. A change in shape or form is generally recognized as being within the level of ordinary skill in the art. In re Dailey, 149 USPQ 47 (CCPA 1976). Furthermore, a skilled artisan when reviewing the combination of Leighton and Buchman would have been well aware of the need to accommodate the shape of the slider mounted on the zipper length so as to permit the slider mounted on the zipper to be inserted in the groove of the turret. It being obvious that a skilled artisan would have modified the shape of the turret grooves to accommodate the shape of the slider mounted on the zipper length based on the provision of obvious-to-try rationale.

Concerning claims 6 and 15, the Leighton machine discloses a heated sealing bar 36 which is moved toward and away from the film and is located adjacent the attachment location of the zipper and on an opposite side of the web than the turret.

Concerning claims 7, 8 and 18, the Buchman reference teaches a roller nip 165 which would have been obvious to combine with the Leighton machine in order to feed the zipper and slider to the groove of the turret. Furthermore, to have made the roller nip adjustable to allow the slider to pass there through would have been obvious to a skilled artisan in order to prevent damage to the roller nip. Concerning the roller surfaces being convex, it would have been an obvious matter of design choice to have had the roller surfaces be convex, since applicant has not disclosed that having a convex roller surface solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with non-convex roller surfaces.

Concerning claims 9 and 19, the form/fill/seal machine is disclosed by Leighton.

**9.** Claims 2, 3 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art as applied to claims 1 and 14 above, and further in view of applicant's admitted prior art.

Concerning claims 2 and 16, the Leighton apparatus, as modified by Buchman, does not expressly disclose that the slider mounting device for mounting the slider to the zipper is a rotary slider applicator, but applicant admits that rotary slider applicators for mounting a slider to a zipper are old and well known as discussed at page 6 of the present application. It would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have further modified the Leighton

apparatus to have made use of a rotary slider applicator as the slider mounting device for mounting the sliders on the zipper. It being routine for a skilled artisan to combine the teachings and structure of old and well known devices and methods when such a combination would achieve predictable and successful results.

Concerning claim 3, the Leighton reference discloses a knife 18 located just before the zipper is fed into the groove of the turret.

**10.** Claims 10, 11, 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art as applied to claims 1 and 14 above, and further in view of applicant's admitted prior art.

Concerning claims 10, 11, 20 and 21, in the previous Office action the examiner took Official Notice that it is notoriously old and well known in the relevant art to have a machine to receive a zippered web and to convert the zippered web into bags which are subsequently filled, or to have a roll onto which a zippered web may be attached for subsequent use in making bags or for use in a form/fill/seal machine. Since applicant has not challenged the examiner's taking of Official Notice, the holding is deemed to be an admission of applicant's admitted prior art.

Thus, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have further modified the Leighton machine for forming a zippered web to have had a machine arranged to receive the zippered web and convert the zippered web into bags which are subsequently filled, or to attach the zippered web to a roll for subsequent use in making empty bags or for use in a form/fill/seal machine. It being routine for a skilled artisan to apply the teachings of

notoriously old and well known machines and methods to other technology open for similar use and improvement. Such a modification would provide multiple uses for the zippered web formed by the modified Leighton machine and method.

### **Response to Arguments**

11. Applicant's arguments filed 23 March 2009 have been fully considered but they are not persuasive.

Regarding applicant's arguments concerning the 35 USC 102 rejections of claims 12 and 13 using the Fraser or DeBolt references -- the applicant's argument that neither reference has anything to do with engaging the profiles of a slider zipper is noted but deemed unpersuasive. Applicant's arguments, page 10 of the response filed 23 March 2009, with respect to the 35 USC 102 rejection of claims 12 and 13 are based on the function and/or intended use of the claimed invention found in claims 12 and 13. The argument that either of the Fraser or DeBolt devices is incapable of performing the function of "engaging the profiles of a slider zipper" is noted but deemed unpersuasive. As stated above in the rejection of claims 12 and 13, either of the Fraser or DeBolt devices does in fact meet all of the structural limitations set forth in the claims. As stated above, the language which applicant argues at page 10 of the response is deemed to be functional and/or a statement of intended use. Accordingly, the type of language in claims 12 and 13, as set forth in the above rejection, is afforded little patentable weight as it fails to structurally distinguish the apparatus claim from the apparatus disclosed by the either of the Fraser or DeBolt references. The subject matter of claims 12 and 13 is directed to an apparatus, and it has long been held that an

apparatus claim must structurally distinguish itself from the prior art in order to avoid anticipation under 35 USC 102. From MPEP section 2114,

"While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also In re Swinehart, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original).

Accordingly, the subject matter of claims 12 and 13 is properly rejected under 35 USC 102(b) as anticipated by either one of Fraser or DeBolt as the claims fail to recite any structural feature not already found in either one of Fraser or DeBolt.

Regarding applicant's argument concerning the rejection of claims under 35 USC 103, found at page 11 of the response filed 23 March 2009, that the examiner has made use of improper hindsight gained after review of the disclosure, and that such a combination of Leighton and Buchman would not suggest:

the inline application of a slider to a zipper before the zipper is driven into the turret;  
the turret having grooves into which the zipper is driven; and  
the grooves in the turret include a wider portion for receiving the slider on each pre-cut zipper length.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon

hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See In re McLaughlin, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this instance, a person having ordinary skill in the art would on reviewing the reference as well as taking into account the general knowledge of a person having ordinary skill in the art would have found that it is quite obvious to combine the teachings and suggestions of the prior art references to Leighton and Buchman. Given the fact that it is routine for a skilled artisan to combine old and well known structures and methods of their use, it is difficult to understand how a person of ordinary skill in the art would be guilty of relying on knowledge not easily found from the prior art or general knowledge. The examiner thus cannot be considered to have made the conclusion of obviousness based on improper hindsight reasoning.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the conclusion of obviousness of the claimed subject matter is based on what is found in the applied prior art as well as the knowledge of a person having ordinary skill in the relevant art. All of

the features or limitations of the claims are found in the applied prior art or have been properly addressed by the examiner in the rejection of the relevant claims. The limitations which applicant has argued at page 11 of the response are sufficiently taught or suggested by the prior art, and they have been combined in a manner which does not produce results which a skilled artisan would find unexpected or unsuccessful. The modifications to the prior art to arrive at the claimed subject matter take into account only knowledge directly from the prior art references or that which is reasonably expected to be known by a skilled artisan.

### **Conclusion**

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen F. Gerrity whose telephone number is 571-272-4460. The examiner can normally be reached on Monday - Friday from 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Stephen F. Gerrity/  
Primary Examiner, Art Unit 3721